

REMARKS

Claims 1-14 are pending.

Claims 1 and 4 are independent claims.

Reply to Rejections

First Rejection:

Claims 1, 4, 5-7 and 11-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasutake (U. S. Patent 5,729,249) in view of Ide et al. (hereinafter "Ide", U. S. Patent 5,598,187). This rejection is traversed.

Initially, the rejection fails to establish a *prima facie* case of obviousness because (1) the structure claimed is not shown or suggested by the references and/or (2) the motivation set forth for combining the references is speculation.

Initially, the Examiner does correctly recognize that one difference between Yasutake and base claims 1 and 4 is the structure set forth in the last paragraph of each of these claims. The Examiner relies on Ide with an assertion that the structure in column 24, line 43 to column 25, line 43 and column 26, lines 1-5 show the structure in the last paragraph of claims 1 and 4. Actually, the portions relied on by the Examiner are claims 1-4 and 7 of Ide.

For the convenience of the Examiner, a summary of the pertinent portions of Ide does not disclose or suggest the substance of what is claimed in the last paragraph of claims 1 and 4.

Ide discloses a spatially movable mouse. In accordance with the movement of the mouse in the space, a pointer on the screen is traced. The subject matter of Ide is similar to a laser pointer but is different from such a laser pointer as the cursor on the screen is not generated optically but electronically by controlling the cursor movement in accordance with the spatial movement of the mouse. The linear movements of the mouse are merely transferred to linear movements of the cursor, and, in particular, would always be the same if, e.g., the mouse is rotated.

This means that if, for example, the cursor is an inclined arrow, the orientation of the arrow on the screen would be always the same irrespective of how the mouse is moved in space.

Thus, Ide clearly indicates not to control the orientation of the object on the screen when the orientation of the mouse is changed.

Thus, one of the main differences of the subject matter of claims 1 and 4, corresponding to the detected orientation, i.e., rotational position, of the housing of the input device, control signals are generated for the display device for orienting the object shown on the display device according to the actual orientation of the input device, i.e., for displaying the object on the

screen with an orientation corresponding to the actual orientation of the input device is not shown or suggested by Ide.

Thus, the combination of the two references does not show or suggest what is claimed.

Furthermore, even if Ide shows what was asserted in the Office Action, which it does not, as explained above, the motivation set forth in the Office Action is truly speculation. That is, the Office Action fails to point out what specific disclosure in claims 1-4 and 7 of Ide would suggest to one skilled in the art a motivation to change the base reference.

With respect to the dependent claims, these claims are considered patentable, at least for the same reasons as the base claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Second Rejection:

Claims 2, 3 and 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasutake, in view of Ide, as applied to claims 1, 4, 5-7 and 11-14, as above, and further in view of Levin et al., (hereinafter "Levin", U. S. Patent 6,154,201). This rejection is traversed.

As explained above, the first two references, i.e., Yasutake and Ide, do not show or suggest what is set forth in the base claims 1 and 4. The

addition of Levin does not cure the innate deficiencies of the rejection based on Yasutake in view of Ide.

Also, the Examiner is again requested to consider the date of Levin (6,154,201), November 28, 2000. While this reference is a continuation-in-part of two applications, the second application does refer to U. S. Patent 5,825,308. A cursory review of this patent (5,825,308) does not show what was asserted in the Office Action of May 27, 2003, Section 6.

In any case, Levin does not cure the inherent deficiencies of the rejection based on the first two references, as set forth above.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Reply to Response to Arguments

In Section 5 of the Office Action, the Examiner stated that the previous arguments were not persuasive. This is not understood as clearly the Examiner has now provided a new rejection, as explained in Section 6 of the Office Action.

Additional Art Cited

In Section 7 of the Office Action, the Examiner asserted that "additional cited references anticipate the claimed material and render the

claims obvious.” This comment is not understood. Anticipation is under 35 U.S.C. § 102, while obviousness is under 35 U.S.C. § 103.

In any case, as the additional cited reference was not applied, no comments are considered necessary. See *In Re Hoch*, 166 USPQ 406, 407 n.3 (CCPA 1970), also cited in MPEP § 706.02(j), wherein the Court stated as follows:

“Where a reference is relied on to support a rejection whether or not in a minor capacity, that reference should be positively included in the statement of the rejection.”

Clearly, the patent cited, as it has not been applied, is not considered evidence.

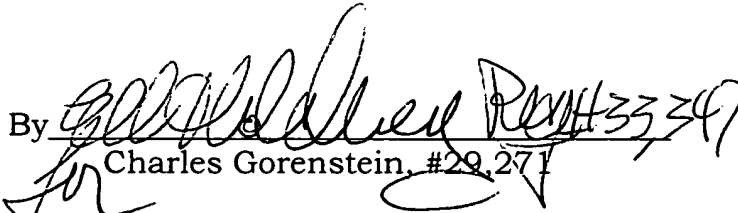
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  Charles Gorenstein, #29,271

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

CG/EAG/slb
0179-0167P